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Filing date: **07/18/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Masimo Corporation		
Entity	Corporation	Citizenship	Delaware
Address	40 Parker Irvine, CA 92618 UNITED STATES		

Attorney information	Deborah S. Shepherd Knobbe, Martens, Olson & Bear, LLP 2040 Main Street, 14th Floor Irvine, CA 92614 UNITED STATES efiling@kmob.com Phone:949-760-0404
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Registration Subject to Cancellation

Registration No	2916730	Registration date	01/04/2005
Registrant	Medtronic, Inc. 710 Medtronic Parkway Minneapolis, MN 554325604 UNITED STATES		
Goods/Services Subject to Cancellation	Class 010. First Use: 2003/11/14 , First Use In Commerce: 2003/11/14 Goods/Services: medical device, namely, implantable cardioverter defibrillator, parts and fittings therefor		

Attachments	2006-07-18 Petition to Cancel.pdf (7 pages)(331069 bytes)
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Signature	/deborah s. shepherd/
Name	Deborah S. Shepherd
Date	07/18/2006

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**In the Matter of Trademark Registration No. 2,916,730
For the Mark MAXIMO
Registered on January 4, 2005**

Masimo Corporation,
Petitioner,

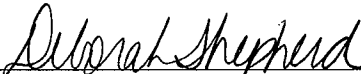
v.

Medtronic, Inc.,
Registrant.

) I hereby certify that this correspondence and all marked
) attachments are being electronically filed with the Trademark
) Trial and Appeal Board through their web site located at
) <http://estta.uspto.gov> on

) July 18, 2006

) (Date)

) 
) Deborah S. Shepherd

PETITION TO CANCEL

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir or Madam:

Petitioner, Masimo Corporation, a Delaware corporation located and doing business at 40 Parker, Irvine, California 92618 ("Masimo"), believes that it is or will be damaged by U.S. Registration No. 2,916,730 for the mark MAXIMO, owned by Medtronic, Inc., a Minnesota corporation located and doing business at 710 Medtronic Parkway, Minneapolis, Minnesota 55432-5604 ("Registrant"). Accordingly, Petitioner hereby petitions the Trademark Trial and Appeal Board to cancel U.S. Registration No. 2,916,730.

A description of Registrant's registration is as follows:

Mark	:	MAXIMO
Registration No.:	:	2,916,730
Filed	:	April 17, 2003
Registered	:	January 4, 2005
Int'l. Class	:	10
Alleged Date of First Use	:	November 14, 2003
Goods	:	Medical device, namely, implantable cardioverter defibrillator, parts and fitting therefor

As grounds for the cancellation, it is alleged:

1. Petitioner, Masimo Corporation, is a medical technology company founded in 1989 that develops, licenses, sells, and markets advanced medical signal processing technologies and products for non-invasive patient monitoring. Masimo is known for its revolutionary technology and its high quality, gold standard products that are offered under the MASIMO mark. Since at least as early as November 17, 1994 and long prior to the acts of Registrant, Masimo has been using the mark MASIMO in connection with various medical-related goods. The use of this mark has been valid and continuous and has not been abandoned.

2. Many years prior to Registrant's adoption and registration of the MAXIMO mark, Registrant became a licensee of Masimo's MASIMO SET patented technology and of the MASIMO trademark. For example, Registrant, as a licensee, has used Masimo's MASIMO mark in Registrant's website and in marketing materials to promote Registrant's LifePak 20 defibrillator/monitor which utilizes Masimo's MASIMO SET technology. As such, long prior to adopting and registering the MAXIMO mark, Registrant had actual knowledge of Masimo's MASIMO trademark, Registrant acknowledged the validity of Masimo's rights in the MASIMO trademark, and Registrant relied on the goodwill and reputation of Masimo's MASIMO mark to promote Registrant's own products.

3. Registrant's LifePak 20 product and other products are used with accessories manufactured and sold by others. Registrant provides information on its website about accessories that work with Registrant's LifePak 20 and other products. For example, Registrant provides information on Registrant's website about Masimo's MASIMO SET SpO2 Patient Cables and MASIMO SET SpO2 sensors and advertises them as suitable accessories for the LifePak 20. Registrant uses the MASIMO trademark on numerous occasions throughout its website.

4. Registrant had long been using the MASIMO mark under license from Masimo in connection with Registrant's own products, had long been relying on the goodwill and reputation of the MASIMO mark to sell Registrant's own products, and had long been advertising Masimo's accessories on Registrant's website when Registrant adopted and registered the mark MAXIMO. Based on these facts and others, Registrant adopted and registered the MAXIMO mark in bad faith.

5. Masimo is the owner of U.S. Registration No. 2,834,864 for the mark ACCURATE MONITORING WHEN YOU NEED IT MOST. Registrant has adopted and is now using the slogan CONFIDENCE WHERE IT IS NEEDED MOST in connection with the MAXIMO mark. Registrant is also using the MAXIMO mark in a font that is similar to the font used by Masimo for its MASIMO mark. The use of a similar font for the MAXIMO mark and the use of a slogan similar to Masimo's registered mark in connection with the MAXIMO mark further exacerbate the likelihood of confusion between the MASIMO and MAXIMO marks. These facts also evidence that Registrant's adoption and registration of the MAXIMO mark was in bad faith.

6. Masimo is the owner of and relies on incontestable United States Trademark Registration No. 1,906,425 for the mark MASIMO for "in vivo patient monitors for detecting a physiological condition" in International Class 10, which issued on the Principal Register on July 18, 1995. The registration issued from an application that had been filed in the United States Patent

and Trademark Office (“PTO”) on September 30, 1993. Masimo has used the MASIMO mark on the goods identified in the registration since at least as early as November 17, 1994. Masimo first used its MASIMO mark and obtained its registration long before Applicant allegedly first used the MAXIMO mark and filed the application which matured into U.S. Registration No. 2,916,730.

7. Masimo is the owner of and relies on incontestable United States Trademark Registration No. 1,951,663 for the mark MASIMO for “electronic in vivo monitors, namely, blood monitors” in International Class 10, which issued on the Principal Register on January 23, 1996. The registration issued from an application that had been filed in the PTO on October 16, 1992. Masimo has used the MASIMO mark on the goods identified in the registration since at least as early as November 17, 1994. Masimo first used its MASIMO mark and obtained its registration long before Applicant allegedly first used the MAXIMO mark and filed the application which matured into U.S. Registration No. 2,916,730.

8. Masimo is the owner of and relies on United States Trademark Registration No. 2,834,864 for the mark ACCURATE MONITORING WHEN YOU NEED IT MOST for “medical apparatus comprised of computer software, computer hardware and in vivo sensors for medical use, namely, for blood constituent monitoring, electrical activity monitoring, and hemodynamic monitoring” in International Class 10, which registered on the Principal Register on April 20, 2004. The registration issued from an application that was filed in the PTO on November 22, 2000. Masimo has used the ACCURATE MONITORING WHEN YOU NEED IT MOST mark since at least as early as July 2001. Masimo first used its ACCURATE MONITORING WHEN YOU NEED IT MOST mark and filed its application for this mark long before Applicant allegedly first used the MAXIMO mark and filed the application which matured into U.S. Registration No. 2,916,730.

9. Masimo's U.S. Registrations specified in Paragraphs 6, 7, and 8 above (collectively "Masimo's Federal Registrations") are valid, subsisting, unrevoked, uncanceled, and not abandoned. As such, they constitute prima facie evidence of the validity of the registered marks and of the registrations thereof, and of Masimo's ownership of the marks shown therein and Masimo's exclusive right to use the marks in commerce in connection with the goods named therein, without condition or limitation. Moreover, Masimo's registrations in Paragraphs 6 and 7 are incontestable. Masimo's Federal Registrations also constitute notice to Registrant of Masimo's claim of ownership of the marks shown therein, all as provided in Sections 7(b), 15, 22 and 33(a) of the Trademark Act of 1946, as amended.

10. In view of the substantial similarity between the respective marks and the related nature of the goods of the respective parties, it is alleged that mark shown in U.S. Registration No. 2,916,730 so resembles Masimo's registered MASIMO marks as to be likely to cause confusion or to cause mistake or deceive under Section 2(d) of the Trademark Act.

11. Masimo's use of its MASIMO marks has been valid and continuous since at least as early as November 17, 1994 and has not been abandoned. The MASIMO name and marks are symbolic of extensive goodwill and consumer recognition built up by Masimo through substantial amounts of time and effort in advertising and promotion. By reason of Masimo's widespread and continuous use of the MASIMO name and marks, and in addition to the protection afforded by the federal registrations for its marks, Masimo has extensive, non-registered statutory and common law rights in the MASIMO name and marks. In view of the similarity of the respective marks and the related nature of the goods of the respective parties, it is alleged that Registrant's registered mark so resembles Masimo's mark previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake or to deceive.

12. Consumers associate the MASIMO mark with high quality, gold standard products, and revolutionary technology. The MASIMO name and marks, by virtue of substantial sales, use, and promotion, have acquired great value as an indicator of Masimo and its goods, and distinguishes them from the goods of others. Indeed, through extensive use and advertising of the MASIMO name and marks, the name and marks have become famous for Masimo's goods since a date well prior to the filing date of the application that matured into U.S. Registration No. 2,916,730.

13. In view of Masimo's prior rights in the MASIMO name and marks, Medtronic is not entitled to registration of the MAXIMO mark pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

14. Further, as set forth in Paragraphs 2, 3, 4 and 5 above, Registrant has adopted and registered the MAXIMO mark in bad faith for the purpose of creating a false association and/or with the intent to otherwise trade off the goodwill and reputation of Masimo's marks which are associated with high quality, gold standard products and revolutionary technology.

15. Registrant's use and registration of the MAXIMO mark will dilute the distinctive quality of the MASIMO marks within the meaning of Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), and will lessen the ability of the MASIMO marks to distinguish the products of Masimo, regardless of the category of products in connection with which Medtronic uses the MAXIMO mark.

16. Medtronic has no license, consent or permission from Masimo to use or register the MAXIMO mark. Masimo has been in ongoing negotiations with Medtronic, which negotiations have been unsuccessful toward resolving this matter.

17. By reason of all the foregoing, Masimo is and will continue to be gravely damaged by U.S. Registration No. 2,916,730 because this registration is in violation of Masimo's trademark and trade name rights.

WHEREFORE, Masimo prays that U.S. Registration No. 2,916,730 be cancelled, and that this Petition to Cancel be sustained in favor of Masimo. Please charge Deposit Account No. 11-1410 for any fees which may be required, or credit any overpayment to this account.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: July 18, 2006

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